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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/061,417	04/16/98	OLSON	E UTSD:548

STEVEN L. HIGHLANDER
ARNOLD, WHITE & DURKEE
P O BOX 4433
HOUSTON TX 77210-4433

HM22/0120

EXAMINER

BAKER, A

ART UNIT	PAPER NUMBER
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1632

8

DATE MAILED: 01/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

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Office Action Summary

Application No.
09/061,417

Applicant(s)
Olson et al.

Examiner
Anne-Marie Baker, Ph.D.

Group Art Unit
1632



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-40 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-40 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claims 1-40 are pending in the instant application.

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 2, 4, 6, 7, and 9-11, drawn to a method of treating hypertrophy in a cardiomyocyte cell by inhibiting the function of NF-AT3, wherein the agent contacting the cell is an antibody, a small molecule inhibitor, or a polypeptide, classified in class 514, subclass 2.
- II. Claims 1, 3, 5, 8, and 12, drawn to a method of treating hypertrophy in a cardiomyocyte cell by inhibiting the function of NF-AT3, wherein the agent contacting the cell is an antisense construct, classified in class 536, subclass 24.5.
- III. Claims 13, 14, 16, 20, 21, and 22, drawn to a non-human transgenic mammal comprising a heterologous NF-AT3 gene under the control of a promoter active in eukaryotic cells, classified in class 800, subclass 13.
- IV. Claims 15, 17, 18, 19, and 23-40, drawn to a non-human transgenic mammal comprising a heterologous NF-AT3 gene having at least one mutation that destroys a phosphorylation site, classified in class 800, subclass 13.

Claim 1 embraces the inventions of Groups I and II. Should either Group I or II be elected, Claim 1 will be examined only to the extent that it encompasses the elected subject matter.

The inventions are distinct, each from the other because of the following reasons:

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Inventions I and II are patentably distinct because the inventions constitute distinct methods, requiring the use of different starting materials and different modes of operation. For example, the antisense molecule administered in the method of the invention of Group II is structurally, functionally, and biologically distinct from the agents administered in the method of the invention of Group I. Thus, the methods of the inventions of Groups I and II are patentably distinct.

Invention I and either of III or IV are patentably distinct because the inventions are drawn to methods and compositions that are unrelated. The transgenic animal of the invention of Group III is not required to practice the method of the invention of Group I. The transgenic animal of the invention of Group IV is not required to practice the method of the invention of Group I. Thus, the claimed method and transgenic animals are patentably distinct.

Invention II and either of III or IV are patentably distinct because the inventions are drawn to methods and compositions that are unrelated. The transgenic animal of the invention of Group III is not required to practice the method of the invention of Group II. The transgenic animal of the invention of Group IV is not required to practice the method of the invention of Group II. Thus, the claimed method and transgenic animals are patentably distinct.

Inventions III and IV are patentably distinct because the inventions are drawn to materially different compositions that are not directly related. The NF-AT3 transgenic animal of the invention of Group III would be expected to have a phenotype different from the mutant NF-AT3 transgenic animal of the invention of Group IV. Thus the animals would have different uses. The animals would be biologically and genetically different from each other. The inventions are drawn to compositionally and functionally different animals

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which require non-coextensive areas of search and consideration. Thus, the claimed transgenic animals are patentably distinct.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter and because the searches required for the separate inventions are not coextensive, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne-Marie Baker whose telephone number is (703) 306-9155. The examiner can normally be reached Monday through Thursday and alternate Fridays from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jasmine Chambers, can be reached on (703) 308-2035. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-8724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Anne-Marie Baker, Ph.D.

Jasmine P. Chambers
JASEMINE CHAMBERS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600